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Brief
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
CHERYL B. LEBEAU, et al : Group Art Unit: 2854
Application No: 09/303,632 : Examiner: L. J. Evanisko
Filed: May 3, 1999 :
For: DISPOSABLE PLASTIC KEYBOARD COVER :

Assistant Commissioner for Patents
Washington, DC 20231

APPELLANT'S BRIEF (37 C.F.R. § 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on 5/21/2002.

The fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate. (37 C.F.R. § 1.192(a))

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))

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Date: July 22, 2001

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This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 1.192 (c)):

- I. REAL PARTY INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF INVENTION
- VI. ISSUES
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- VIII. ARGUMENTS

ARGUMENT: VIIIA REJECTIONS UNDER 35 U.S.C. 103(a)

ARGUMENT: VIIIB REJECTIONS UNDER 35 U.S.C. 103(a)

ARGUMENT: VIIIC REJECTIONS UNDER 35 U.S.C. 103(a)

- IX. APPENDIX OF CLAIMS INVOLVED IN THE APPEAL
- X. OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY OR DESIRABLE

The final page of this brief bears the practitioner's signature.

- I. REAL PARTY IN INTEREST (37 C.F.R. § 1.192(c))(1))

The real party in interest in this appeal is:

the party named in the caption of this brief.

- II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 1.192(c)(2))

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal:

there are no such appeals or interferences.

- III. STATUS OF CLAIMS (37 C.F.R. § 1.192(c)(3))

The status of the claims in this application is:

- A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 21-38, 41 and 42 (Total Claims = 20)

B. STATUS OF ALL OF THE CLAIMS

1. Claims cancelled: 1-20; 39-40
2. Claims withdrawn from consideration but not cancelled: None
3. Claims pending: 21-38; 41, 42
4. Claims allowed: None
5. Claims rejected 21-27; 32-38
6. Claims objected to: 28-31; 41, 42

C. CLAIMS ON APPEAL

The claims on appeal are: 21-27; 32-38

IV. STATUS OF AMENDMENTS (37 C.F.R. § 1.192(c)(4))

An amendment was filed on August 22, 2001 after an Office action of May 22, 2001. The Examiner filed a Final Action dated November 21, 2001.

V. SUMMARY OF INVENTION (37 C.F.R. § 1.192(c)(5))

- A. The present invention (FIGS. 3-5) is a package (33) of individual disposable transparent covers (23) having a predetermined size in length and width. Each cover (23) includes a thin film of clear plastic material having two lines of adhesive (24) on the cover (23) and positioned to contact a keyboard frame (32) without interfering with the operation of a keyboard (20) and the associated keys (21). The lateral edges of a cover (23) may extend beyond the lateral edges of the keyboard (20).
- B. A second embodiment (FIGS. 6 and 7) of a cover (25) includes a plastic envelope having an open side (26) and three closed sides (31). The envelope may be formed by folding a single sheet of plastic film over itself and heat sealing the edges (31) or by heat sealing two superimposed sheets of plastic film along three side edges (31).
- C. A third embodiment (FIGS. 8 and 9) of the cover according to the invention is an open-ended tubular sleeve preferably formed by folding a plastic film to form two layers (28) with two open ends (29) and two elongate sides (30) (31). Sealed side (30) terminates generally medially at point (30A) to allow an opening (30B) to accommodate an electrical cord that connects the keyboard (20) to a computer

(not shown). The sleeve can also be formed in a manner similar to sleeve (25) by using two single layers (28).

VI. ISSUES (37 C.F.R. § 1.192(c)(6))

The final rejection is grounded on 35 U.S.C. 103(a).

The issues on appeal are as follows:

A. Whether Claims 21 and 22 are unpatentable over Nopper et al in view of Richardson?

B. Whether Claims 22-23 and 33-34 are unpatentable over Nopper et al in view of Richardson and in view of Morse?

C. Whether Claims 24-27 and 35-38 are unpatentable over Nopper et al in view of Richardson and in view of Weill et al?

VII. GROUPING OF CLAIMS (37 C.F.R. § 1.192(c)(7))

The Claims in the present application are grouped as follows:

- (a) Claims 21 and 32 are grouped together;
- (b) Claims 22-23 and 33-34 are grouped together;
- (c) Claims 24-27 and 35-38 are grouped together;
- (d) Claims 28-31 are grouped together; and
- (e) Claims 41 and 42 are grouped together.

VIIID. ARGUMENTS-REJECTIONS UNDER 35 USC § 103 (37 C.F.R. §1.192(c)(8)(IV))

A. Claims 21 and 32 are believed to be patentable over Nopper et al in view of Richardson.

(1) Nopper et al discloses a silicone rubber elastomeric material preferably injection molded (col. 3, lines 45-55) in which the surface overlying the keys is thicker than the side wall portions depending downwardly of the sides of the keys. While Nopper et al mentions that in the preferred embodiment the cover is "partially transparent" (col. 3, lines 37-45) to permit the indicia of the keys to be viewed by the operator, such "partially transparent" is not believed to equate to, for example, in Claim 21 (Twice Amended) "at least one flat and transparent sheet of pliable plastic film".

In addition, the cover of Nopper et al does not imply or render obvious that the cover is "disposable" by virtue of being constructed of low-cost material as argued by the Examiner, (Final Action ("FA") p.3). Moreover, the naked assertion that "everything can be broadly considered 'disposable' to some extent" (FA, p.3) does not imply or render obvious the present cover. Indeed,

the Nopper et al cover "does not necessarily state that the cover is 'disposable'" as admitted by the Examiner (FA, p.3), nor is it well known to throw away such a form fitted cover overlying and encasing keys of a keyboard.

A "film" is normally considered to be and have a definition of "a thin skin" unlike that depicted and described in Nopper et al and certainly Nopper et al does not disclose that their membrane is flat or even thin or even transparent as set forth in the instant application. It is inherent in the instant invention that the plastic film not be shaped to conform to the keys of a keyboard of Nopper et al, which uses a resilient elastic material preformed to the keys of a keyboard thus greatly increasing costs and rendering Nopper et al certainly not intended to be readily disposable except after sufficient wear or tear or when in no longer can function in the intended use thereof, i.e., after being spent. This is even more apparent by having the cover connected by the bottom plate 40 and screws 41. On the other hand applicants' invention may be readily disposed after each and every single use, particularly when used in a dental practice, or medical practice, or even in libraries or the like. It is clear that Nopper et al teaches away from such single use of their formed elastomeric fitted membrane cover.

With respect to Claim 21, Richardson does not supply a "package" of covers having predetermined length and width but supplies only a supply of plastic film that may be cut to the desired length. While applicants do not disagree that a cardboard box of a dozen or two dozen Nopper et al preformed elastic covers may be packaged for sale and/or shipment, Nopper et al does not envision such arrangement nor would one of ordinary skill in the art consider that such packaged covers of Nopper et al was for the purpose "to provide a convenient supply of fresh disposable items to a user" as only suggested by the Examiner. Nor would the cover of Nopper et al be supplied on a roll such as in Richardson.

(2) Claims 22-23 and 33-34 are believed to be patentable under 35 U.S.C.103(a) over Nopper et al '638 for substantially the same reasons set forth above and over Morse '300. Morse is directed to a preformed cover made of an elastomeric material, such as rubber, wherein indicia is provided on the outside corresponding to the indicia on the underlying button (col. 3, lines 26-31). In view of Nopper et al disclosing a more secure manner of attaching their cover by the plate 40, screws 41, it would seem even more unlikely (than likely) that one skilled in the art would somehow employ adhesive strips of Morse as any obvious substitution for the attachment of Nopper

et al. Also, one should note the use of Morse for a long time in view of materials employed by Morse.

(3) Claims 24-27 and 35-38 are believed to be patentable under 35 U.S.C.103(a) over Nopper et al, as set forth above, with respect to Claims 21 and 32 and further over Weill et al '297. Weill et al does not describe, nor does Nopper et al, any disposable film covers to which applicants' invention is directed. The purpose of the cover of Weill et al is to house an entire portable computer and would not teach ^{one} having ordinary skill in the art to follow the Examiner's suggested reconstruction of Nopper et al which itself is only directed to a long lasting keyboard cover. Weill et al is directed to a cover for an entire computer so that the computer may be used in wet weather. Neither Nopper et al nor applicants' invention is directed to a cover used for the purposes of Weill et al. Weill et al discloses that the interior wall 17 is transparent and the remaining, non-transparent portions are made of a durable, waterproof material, such as nylon (col. 4, lines 53-61) and certainly is not intended to be at all disposable before being spent. Also, Weill et al describes an element much like a glove (col. 4, lines 23-26) with pockets, unlike Nopper et al and applicants' invention. It would seem that the Examiner has selected components from Weill et al and reconstructed Nopper et al. Applicants suggest that the Examiner has used applicants' disclosure in retrospect to arrive at a reconstruction allegedly supporting an obviousness rejection. Applicants believe that such hindsight reconstruction is contrary to the intent and accepted implementation of 35 U.S.C. 103(a).

(4) With respect to Claims 26 and 37, the glove form of a cover of Weill et al is not believed to be an "envelope", as suggested by the Examiner, nor does the edge portion 18 (FIG. 1) of Weill et al appear to be a top edge of 17 (that which covers the keyboard), particularly when while in use 18 is folded up and maintained on the back of wall 23.

(5) With respect to Claims 27 and 38, the glove form of the cover of Weill et al is not believed to be an envelope, as commonly understood, nor does any art of record support the Examiner's contention that "there is no unobviousness in providing an opening along any edge portion of a cover for ease of entry (such as in a sleeping bag)" (FA, p. 6). These claims specifically call for structure not found in any of the prior art. The fact that sleeping bags may have zippered openings along various edges, an unrelated art, would not obviously suggest the claimed structure set forth in Claims 27 and 38.

II. APPLICABLE LAW

The Federal Circuit has recently reviewed the standards that are to be applied in analyzing an application for obviousness under 35 U.S.C. 103 in the case of *In re Lee*, 277 F3d 1338, 61 USPQ 2d 1430 (2002).

The court stated that it is fundamental that a rejection for obviousness must be based on evidence that is comprehended by the language of the statute. When the issue is obviousness “the search for and analysis of the prior art includes evidence relevant to the finding of whether there is teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” Accordingly, the central question is whether there are reasons to combine the references. Teachings of references can be combined only if there is some suggestion or incentive to do so.

The Court further found that the case law required that there must be some motivation, suggestion, or teaching regarding the desirability of making the specific combination that was made by the applicant. The Court further stated:

“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”

Lee case at 1433, quoting *In re Dembiczak*, 175 F3d 994, 999, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999).

The Court further found that the need for specificity was pervasive in the prior case law and that

“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”

quoting *In re Kotzab*, 217 F3d 1365, 1371, 55 USPQ 2d 1313, 1317 (Fed. Cir. 2000).

In addition, the factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority, *Lee* case at 1434.

In the *Kotzab* case, the Federal Circuit Court stated:

“A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field...Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.’...

Most if not all inventions arise from a combination of old elements...Thus, every element of a claimed invention may often be found in the prior art... However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention...Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant...Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference...The motivation suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved... In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references...The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” [At 1316-1317(all internal citations being omitted)].

A primary purpose of the invention of Nopper et al is to prevent entry of contaminants between the keys and the deck of the keyboard and not only uses a thick silicone rubber elastomer to do so and to affix same therebeneath with a plate and screws. No one familiar with Nopper et al would be led or even motivated to the disposable thin and pliable plastic film of uniform thickness and of a predetermined size in both length and width as claimed in the present application. The recitation of the components of Nopper et al in and of themselves suggests nothing but that such components are found in the prior art (Kotzab case above).

Applicant takes issue with the Examiner’s contentions that Richardson discloses a package of covers identical in every respect and one skilled in the art would not obviously somehow, nor for

whatever motivation, substitute Richardson's sheet on a roll for Nopper's molded sheet, except by viewing applicant's disclosure and claims in hindsight.

Accordingly, applicants believe that each of the claims, herein appealed should be found to be allowable and this Board should reverse the Examiner.

IX. APPENDIX OF CLAIMS (37 C. F. R. § 1.192(c) (9))

21. (Twice Amended) A package of individual disposable transparent covers of a predetermined size in length and width for protecting the sterility of a keyboard of a computer, each said cover comprising at least one flat and transparent sheet of pliable plastic film of uniform thickness and a predetermined size in length and width to contact and protect an entire upper surface of a keyboard, said sheet inhibiting any unintentional contact between a keyboard and fingers of an operator while not impeding an operator's ability to manipulate a keyboard in a speedy and accurate manner.
22. (Amended) The package of Claim 21 wherein said at least one sheet is rectangular, having a long top edge portion, a long bottom edge portion, and two short side edge portions, a strip of adhesive along at least said top edge portion adapted to be attached along a top edge portion of a keyboard.
23. (Amended) The package of Claim 21 wherein said at least one sheet includes top and bottom edge portions, a pair of spaced strips of adhesive along respective said top and bottom edge portions adapted to be attached along elongated upper and lower portions of an upper surface of a keyboard.
24. (Twice Amended) The package of Claim 21 wherein said at least one sheet contacts and protects entire upper and bottom surfaces of a keyboard to maintain a keyboard sterile.
25. (Amended) The package of Claim 21 wherein said at least one sheet is formed with an upper member and a lower member, said upper member being adapted to overlie an upper surface of a keyboard and said lower member being adapted to underlie a bottom surface of a keyboard.
26. (Amended) The package of Claim 24 wherein said at least one sheet is formed as an envelope with an elongated opening along an elongated top edge portion.
27. (Amended) The package of Claim 24 wherein said at least one sheet is formed as an envelope with an elongated opening adjacent one corner and extending along one side edge portion and generally to a midpoint along a top edge portion.

28. (Amended) The package of Claim 21 wherein said at least one sheet includes a pair of identical flat sheets of plastic film, each said sheet having an elongated top edge portion, an elongated bottom edge portion, and two short side edge portions, said sheets being fastened together along said bottom edge portion of each said sheet so as to envelope entire upper and bottom surfaces of a keyboard.
29. The package of Claim 28 wherein said two identical flat sheets of said plastic film are fastened together along each of said side edge portions with one long opening along said top edge portion to permit a keyboard to be inserted therein so as to cover both upper and bottom surfaces of a keyboard.
30. The package of Claim 28 wherein said two identical flat sheets of plastic film are also fastened together along said elongated top edge portion so as to form an elongated envelope having at least one of said short side edge portions open.
31. The package of Claim 30 wherein said top edge portions of said sheets adjacent said at least one open short side edge portions is open to generally its midpoint.
32. (Twice Amended) An individual disposable transparent having a predetermined size in length and width for protecting the sterility of a keyboard of a computer, comprising a flat and transparent sheet of pliable plastic film of uniform thickness and a predetermined size in length and width to contact and overlie an entire upper surface of a keyboard, said sheet inhibiting any unintentional contact between a keyboard and fingers of an operator of a keyboard while not impeding an operator's ability to manipulate a keyboard in a speedy and accurate manner.
33. The cover of Claim 32 wherein said sheet is rectangular, having a long top edge portion, a long bottom edge portion, and two short side edge portions, a strip of adhesive along at least said top edge portion adapted to be attached along a top edge portion of a keyboard.
34. The cover of Claim 32 wherein said sheet includes top and bottom edge portions, a pair of spaced strips of adhesive along respective said top and bottom edge portions adapted to be attached along elongated upper and lower portions of an upper surface of a keyboard.
35. The cover of Claim 32 wherein said sheet contacts and protects entire upper and bottom surfaces of a keyboard to maintain a keyboard sterile.
36. The cover of Claim 32 wherein said sheet is formed with an upper member and a lower

member, said upper member being adapted to overlie an upper surface of a keyboard and said lower member being adapted to underlie a bottom surface of a keyboard.

37. The cover of Claim 35 wherein said sheet is formed as an envelope with an elongated opening along an elongated top edge portion.

38. The cover of Claim 35 wherein said sheet is formed as an envelope with an elongated opening adjacent one corner and extending along one side edge portion and generally to a midpoint along a top edge portion.

41. A disposable transparent cover individually formed and having a predetermined size for protecting the sterility of a keyboard of a computer, said cover comprising two identical flat transparent sheets of pliable plastic film of a predetermined size to protect an entire upper and bottom surface of a keyboard, said sheet inhibiting any unintentional contact between a keyboard and fingers of an operator of a keyboard while not impeding an operator's ability to manipulate a keyboard in a speedy and accurate manner, and each sheet having an elongated top edge portion, an elongated bottom edge portion, and two short side edge portions, said sheets being fastened together along said bottom edge portion of each said sheet so as to envelop entire upper and bottom surfaces of a keyboard.

42. The cover of Claim 41 wherein said two identical flat sheets of plastic film are fastened together along each of said side edge portions with one long opening along said top edge portion to permit a keyboard to be inserted therein so as to cover both upper and bottom surfaces of a keyboard.

**X. OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY OR
DESIRABLE**

With respect to the claim objections, the applicants do not agree with the Examiner that “a keyboard” should be used in the claims because applicants do not wish to claim the keyboard as part of the structural recitations of the invention.

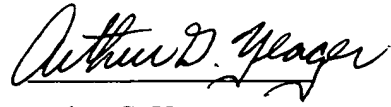
With respect to Claims 21 and 32, applicants are ambivalent as to the need to amend the claims to delete the phrase “a predetermined size in length and width”, as indicated by the Examiner.

Applicants do not agree with the Examiner’s assertion that the phrase “an operator’s ability” be deleted and replaced with “the operator’s ability” because applicants are referring to any given operator not simply one mentioned in an earlier claim or claims.

With respect to Claim 32, applicants agree that —cover—in line 1 was inadvertently omitted and should be inserted after “transparent”.

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Respectfully submitted,

A handwritten signature in cursive script, reading "Arthur G. Yeager". The signature is written in dark ink and is positioned above the printed name.

Arthur G. Yeager

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